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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/538,074

11/18/2005

Jonni Ahlgren

0696-0217PUS1

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2292 7590 02/11/2009
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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

02/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/538,074 | Applicant(s) AHLGREN, JONNI | |
| | Examiner Ana L. Woodward | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 9, 2005; November 7, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on November 07, 2008 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the Office to examine both group inventions. This is not found persuasive because the group inventions have different fields of search, for example, group I is searched in class 524, whereas group II is searched in classes 162 and 427. Accordingly, the search fields for the group inventions are not co-extensive.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 07, 2008.

Claim Rejections - 35 USC § 112

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear if or how the claimed polymer composition is suitable "for peroxide bleaching of a cellulosic fibre material" given that it does not contain a peroxide component.

In claim 1, line 3, it is unclear as to how the awkward language "by bringing in" limits the claimed subject matter.

In claim 1, line 7, do applicants intend "alpha" in lieu of "alfa"?

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In claims 2-6 and 8, it is unclear if or how the narrower ranges, defined in terms of “preferably”, further limit the antecedently recited broader ranges. Said claims do not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In claim 3, the “acidic pH” is broader than the pH of 5 per the base claim. Furthermore, the preferred pH of 5 does not further limit the pH per the base claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,120,556 (Nishino et al).

Nishino et al disclose a stabilizing agent for peroxide-bleaching of fiber material comprising an aqueous solution of (A) a polylactone of a poly-alpha-hydroxyacrylic acid,

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corresponding to applicants' component (B), and (B) a homopolymer or copolymer of (meth)acrylic acid and/or maleic acid, corresponding to applicants' component (A). The aqueous solution preferably has a pH value of 6 to 11 (column 7, lines 40-53, column 8, lines 30-33, etc.). The pH of the aqueous solution is controlled by employing an acid substance. The reference appears to meet all the requirements governing the individual components and their contents.

It is noted that the present claims require a pH of at most 5 while the reference teaches a preferred pH range of 6 to 11. When the claimed range and the prior art range are very similar (i.e., 5 versus 6), the range of the prior art establishes *prima facie* obviousness because one of ordinary skill in the art would have expected the similar ranges to have the same properties. See *In re Peterson*, 65 USPQ2d 1379, 1382. Furthermore, the disclosure by the reference of a preferred embodiment does not teach away from the entire disclosure of the patent, all of which must be considered in the analysis of obviousness. In this case, it is maintained that the reference's preferred lower pH limit of 6 would have at least rendered obvious the use a pH of at least 5 with the reasonable expectation that similar-such acidic pH values would yield similar-such results. Accordingly, absent evidence of unusual or unexpected results for applicants' claimed upper pH limit of 5, as compared to the reference's preferred lower pH limit of 6, no patentability can be seen in the presently claimed subject matter. In this regard, it is noted that the reference does not specifically counsel against using pH values below its preferred range and, in fact, specifically discloses that the pH can be controlled by employing an acid substance.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ana L. Woodward/
Primary Examiner
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